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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,291	11/22/2000	Thomas Jozefiak	1932.1030-025	5051

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HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD, MA 01742-9133

EXAMINER

WANG, SHENGJUN

ART UNIT PAPER NUMBER

1617

DATE MAILED: 06/19/2002 7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,291

Applicant(s)

JOZEFIK ET AL.

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan. 28, 2002 & April 2, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) 1-41, 49-55, 62-70, 75 and 76 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 42-48 and 56-61 is/are allowed.
- 6) ☒ Claim(s) 71-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) & 2. 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-41, 49-55, 62-70 and 75-76 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4 & 6.

2. Applicant's election with traverse of invention group V in Paper No. 4, and species steatorrhea is acknowledged. The traversal is on the ground(s) that group V and group VI should be examined together because of the structural similarity. This is not found persuasive because polymers in group V have the unique dihydroxypropyl group, which is a hydrophilic moiety, wherein polymers in group VI have only alkyl groups or hydrogen. They therefore are structurally distinct from each other. One of ordinary skill in the art would have not expected these two group of polymers be functional similar. Search has been expanded to all species because the elected species was found allowable.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections 35 U.S.C. 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 71-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Niike et al. (JP Patent 04333694).

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5. Niike et al. teach a copolymer wherein a monomer is a substituted diallylammonium. The substituents may be methyl, ethyl, propyl, hydroxylethyl, hydroxylpropyl, and dihydroxylpropyl.

See, particularly, page 3 lines 1-19.

6. Niike et al. does not teach expressly the substituent is a dihydroxylpropyl.

7. However, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ dihydroxylpropyl group as the substituents because dihydroxylpropyl is one of the few known substituents. Regarding claim 72 and 74, note the claims are drawn to composition and therefore the preamble "therapeutic" does not carry any patentable weight. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further, the polymer would read on the composition claimed herein since no other ingredient other than the polymer is defined in the composition.

Allowable Subject Matters

8. Claims 42-48 and 56-61 are found allowable because the prior arts do not teach or fairly suggest the therapeutical application of the polymers herein. The examiner again state that polymers in groups I-VIII are separate and patentably distinct from each other because of their structural difference and the lack of general guidance or direction to one of ordinary skill in the art to make the polymers obvious from each other at the time the claimed invention was made. Attention is directed to US Patent 4,211,765 (Johnson et al., IDS AB). '765 teaches a polymeric

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lipase inhibitor, which may be used for controlling obesity. The polymer has amine moiety and hydrophobic region. However, it is suggested that the polymer may cause steatorrhea, as many known lipase inhibitor does. See, particularly, column1, lines 48-53, and columns 26-28.

Therefore, there is no general guidance or direction that each of the structurally distinct polymers herein would possess the therapeutical properties (including treating steatorrhea) claimed herein and would be obvious from each other.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Examiner



Shengjun Wang

June 10, 2002